



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/103,110 06/23/98 ESKILDSEN

S 042390.P5444

EXAMINER

MM91/1105

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DINH, T

ART UNIT

PAPER NUMBER

2841

DATE MAILED:

11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/103,110

Applicant(s)

ESKILDSSEN ET AL.

Examiner

Tuan T Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The request filed on 10/15/01 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/103,110 is acceptable and a RCE has been established. An action on the RCE follows.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,250,934. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims 1-3 in U.S. Patent 6,250,934 encompass the limitations of the claims 15-24. Application uses the same term "a first receptacle" or "a casing" both performs the same function of "receiving" or "encasing" an IC package. Yet, applicant uses the term "upper opening" as a "first opening" and "back opening" as a "second opening". The "first receptacle" or "casing"

defines the first and second opening that used to cover and protect an IC package when insert into the "first receptacle or casing".

This is provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krehbiel (U. S. Patent 5,026,297) in view of Ringer et al. (U. S. Patent 5,408,386).

As to claims 15-19, Krehbiel discloses an apparatus for use in a data processing as shown in figures 1-9 comprising:

an IC package (12, column 5, line 8) having multiple leads (32, 22, column 5, lines 25-26) extending from IC package (12);

a first receptacle (14) receiving the IC package (see figures 1, 7), the first receptacle (14) comprising a first opening which is a front opening (64, column 6, line 32) such that the first opening (64) receiving the multiple leads (32) and provides an opening (66, column 6, line 34), a second opening which is a back or bottom opening (86, column 7, lines 4-5) such that the IC package (12) is inserted into the first receptacle (14) through the second opening (column 7, lines 5-6), and at least one stop (88;90, column 7, line 9) positioned at the second opening (86) such that the stop holds

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the IC package (12) securely within the first receptacle when the IC package is fully inserted into the first receptacle (14) (see figures 1 and 7).

Krehbiel does not show a second receptacle receiving the first receptacle, the second receptacle comprising multiple electrical contacts to contact the multiple leads of the IC package through the first opening of the first receptacle.

Ringer teaches a second receptacle (12; 14, figure 1 and 2) receiving a first receptacle (13, see figures 1-2, and 4), the second receptacle comprising multiple electrical contacts (41, figure 4) to contact the multiple leads (31) of the IC package through the first opening of the first receptacle.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a second receptacle as taught by Ringer to modify the apparatus of Krehbiel in order to provide an electrical communication between an IC package fit into a receptacle of a computer.

Regarding claims 20-24, the method steps are necessitated by the apparatus structure as it is disclosed by Krehbiel in view of Ringer.

Response to Arguments

Applicant's arguments with respect to claims 15-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

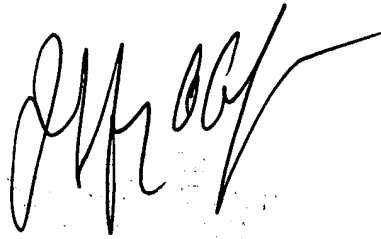
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-308-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A handwritten signature in black ink, appearing to be 'JH Gaffin', with a long horizontal line extending to the right.

TD
November 1, 2001